

## Remarks

Claims 1-7, 9, 11, 13-19, 28-35, and 38-63 are pending. Claims 6, 7, 49-51, and 60-62 are directed to a non-elected species and are withdrawn from consideration pending allowance of a generic claim.

### ***Response to Pending Rejections***

The pending rejections are respectfully traversed and reconsideration is requested based on the amendments herein and the following remarks. The above amendments have been made in an effort to put this application in condition for allowance, without prejudice or disclaimer of any subject matter. Applicant reserves the right to submit additional claims for consideration in further divisional or continuation applications.

#### ***1. Response to 35 U.S.C. 112 Rejections***

Claims 1-5, 9, 11, and 28-37, 42-48, 52-59 and 63 were rejected as being indefinite. The assistance of the Examiner in identifying possible informalities in the claims is noted with appreciation. Reconsideration of these rejections is requested based on the amendments herein. These amendments are made for the purpose of increasing the clarity of the claim language. The amendments are not made to overcome prior art rejections and are not believed to narrow the scope of coverage of any claim.

#### ***2. Response to 35 U.S.C. 102 Rejection***

Claims 38, 42-45, and 53-56 were rejected as anticipated by U.S. Patent 4,320,699 to Binks. In his Figure 2, Binks discloses a flat sheet of Teflon laid in a shallow pan. The

rejection of claims 38, 42-45, and 53-56 on this basis is respectfully traversed and reconsideration is requested based on the following remarks.

Claim 38 recites a liner formed in the shape of a bag, with two side edges and a contoured bottom edge incorporating a central edge portion and two contoured edge portions. It is respectfully submitted that a flat sheet of material such as the one disclosed in Binks cannot anticipate the claimed liner formed in the shape of a bag having specifically defined edges. Claim 42 recites a

pan liner formed with two polymeric sides meeting at side edges and at a single contoured bottom edge and having open top edges, said contoured bottom edge having a single central edge portion and two contoured edge portions extending outwardly from each end of the single central edge to meet said side edges, with said polymeric sides bonded together along at least said two contoured edge portions and said side edges.

It is respectfully submitted that there is no structure in Binks corresponding to the recited structure, with polymeric sides bonded together along specified edges.

Claim 53 recites "liner means comprising two polymeric sides meeting at sealed side edges and having open top edges," and "contoured bottom edge means for providing a sealed bottom of said liner means and preventing the collection of food in a corner of said liner means when installed in said pan means." The claim recites that the contoured bottom edge means has "a single central edge portion and two contoured edge portions extending from each end of the single central edge portion to meet the side edges." The polymeric sides and edge structures defined in this claim cannot be anticipated by a flat sheet of material.

Claims 43-45 dependent on claim 42, and claims 54-56 dependent on claim 53, recite further structural features that are not disclosed in Binks. It is respectfully submitted that claims 43-45 and 54-56 are independently patentable based on the features further defined in these claims. A detailed analysis of each dependent claim is, however, unnecessary since

these claims are patentable by virtue of their dependence on their base claims, for at least the reasons noted above.

**3. *Rejections under 35 U.S.C. 103***

Claims 1-5, 9, 30-38, 42-48, 52-59 and 63 were rejected as obvious based on the combination of Binks, U.S. Patent 3,357,152 to Geigel, and U.S. Patent 4,759,642 to Van Erden. Claims 11, 28, 29 and 39-41 were rejected based on the same combination with the further addition of the M&Q Brochure provided by applicant. The pending claims were also rejected as being obvious based on the combination of Ibsch (2,542,413) or Ferlanti (4,828,134) together with Geigel, Van Erden, and the M&Q Brochure.

Claims 36 and 37 have been cancelled, rendering the rejection of these claims moot. As to the remaining claims, these rejections are respectfully traversed and reconsideration is requested based on the following remarks and the objective evidence of patentability submitted herewith.

The obviousness rejections start with one or more of the Binks, Ibsch, and Ferlanti references. These references show the general concept of a lining for a food vessel. The Binks patent discloses a flat sheet of TFE for this purpose. Ibsch discloses a plurality of removable paper or plastic laminations in the bottom of a food vessel. Ferlanti shows a plurality of nested metal layers on the bottom of a cooking vessel that can be removed to expose a clean surface.

The applicant does not claim to have invented the concept of lining a cooking vessel, which is of course disclosed in Binks and Ferlanti. The applicant *does* claim to be the inventor of a lining with the particular structure defined in the pending claims. None of these three references even teaches or suggests a lining having joined edges, let alone any of the claimed structural features, such as a bag with a contoured bottom edge.

The Binks, Ibsch, or Ferlanti references are combined in the rejections with the newly-cited Geigel and Van Erden patents. Geigel shows a corner-cut thermoplastic bag. However, this bag is not heat resistant; it is designed and sized for use in continuous industrial packaging operations, such as making bags of cement, fertilizer, and other granular materials. Similarly, Van Erden shows a corner-cut cereal box liner designed for filling in a cereal box packaging line. The bags of Geigel and Van Erden have diverse purposes, and neither is intended for use in cooking in the food service industry.

A *prima facie* case of obviousness requires a motivation to modify the structures disclosed in the references to produce the claimed invention. This motivation must be found within the cited references. In this case, it is respectfully submitted that there is no disclosed motivation for the asserted combination.

When the references are examined carefully, it can be seen that the alleged motivations suggested in the Official Action are simply not present. Motivation to make the combination can only be found based on hindsight with the benefit of having knowledge of the present invention.

A key problem solved by the present invention is the collection of food in the corners of a flat bag when the bag is opened and used as a pan liner. The Binks, Ibsch, and Ferlanti designs use flat sheets that conform to the shape of a vessel. Their liners have no bag structure, and therefore no corners that might fill with food. As a result, there is no need in any of these references to prevent that problem. None of the references recognize or address this problem.

The Office Action suggests four motivations for the proposed modifications to Binks, Ibsch, or Ferlanti: (1) eliminate a tendency to snag, (2) improve stackability, (3) avoid cumbersome procedures of gusseted bag manufacture, and (4) free the bottom corners of the

bag from interfering with easy reception and packing of the filled bag in a close fitting carton. Applicant strongly disagrees with the Examiner's position. None of these motivations apply in the context of Binks, Ibsch, or Ferlanti.

Looking at the "motivations" suggested by the Official Action, with regard to motivation (1), the simple structures of Binks, Ibsch or Ferlanti already have no tendency to snag. With regard to motivation (2), when not filled with food, the Binks, Ibsch and Ferlanti sheets are already easily stackable. When used with food, the Binks, Ibsch and Ferlanti sheets cannot be enclosed and are therefore not stackable. Stackability only becomes an issue with bags. With regard to motivation (3), the Binks, Ibsch and Ferlanti sheets already avoid the cumbersome procedures of gusseted bag manufacture. With regard to motivation (4), none of the Binks, Ibsch and Ferlanti sheets has any corners that trap food. Thus, these four motivations alleged by the Examiner have NO relevance to whether Binks, Ibsch or Ferlanti should be combined with Giegel or Van Erden.

In further reference to the asserted motivation of improved stackability, the proposed modifications to Binks, Ibsch and/or Ferlanti would be impractical and a person skilled in the art would have been motivated against combining Giegel or Van Erden with these references. Ibsch and Ferlanti clearly describe the benefits of a multi-layered lining system and have the objective of providing multiple layers that can be removed as they are used. The proposed replacement of the flat sheets by the Van Erden or Geigel bags, taking into account the clear teachings of the references, would require nesting or "stacking" of the completed bags in the cooking vessel. In a practical sense, assembly of the bags of Van Erden or Geigel into nested structures for use as liners would be much a different and more complex problem than a similar assembly of flat sheets. Certainly it is not a problem contemplated by either of these references. A person of ordinary skill in the art, looking at all of the references relied upon

by the Office, would be motivated by these factors against replacing the flat sheets with the claimed bag structures and would see no benefit to such a replacement, since none of these references makes any suggestion of why such a combination would be desirable or beneficial. Thus, the combination of Binks, Ibsch or Ferlanti with the other references, in fact, provides a particularly strong teaching away from the present invention.

In summary, it is only with the benefit of hindsight, using applicant's own disclosure as a blueprint, that a person of ordinary skill in the art would select, from the thousands of bag structures that have been developed, bag shapes similar to those shown in Van Erden and Geigel, create the bags from high temperature material, and substitute these structures for conventional food service pan liners to solve a specific problem experienced in that industry.

The M&Q Plastics brochure, a document created by the assignee of the present invention, was cited by the Examiner in relationship to several of the dependent claims. The M&Q Plastics brochure does not remedy the noted deficiencies of the other references relating to motivation for the proposed modifications.

For the foregoing reasons, it is respectfully submitted that, on balance, there is no motivation in the cited references for a person knowledgeable in this field to modify the cited references as proposed. Indeed, there are a variety of reasons why a person knowledgeable in this field would reject such ideas in a cost-benefit analysis. Without motivation, there is no *prima facie* case of obviousness.

However, to the extent the Office believes there is a *prima facie* case for obviousness, any such case would be overcome by the significant unobvious advantages of the invention when applied to pan liners in the food service industry as evidenced by the available objective evidence of patentability discussed below.

At the time of its introduction, the present invention met with skepticism in the industry. Those seeing the claimed structure for the first time often did not recognize the advantages it would provide. Dr. Melvin Druin, an acknowledged expert in the packaging and plastics industry with many years of experience, indicated in his previously-submitted declaration that he had never seen a liner constructed in this manner. He admitted being puzzled by the contoured edge feature on first inspection. After installing it in a pan and noting the advantage provided by the contoured edge feature, Dr. Druin praised the contour feature.

Further evidence in support of patentability is found in the Rule 132 declaration of Timothy Blucher (filed herewith). The declaration demonstrates the considerable commercial success of the invention and the favorable reaction of the industry to its features. As set forth in the declaration, the claimed contour shape feature is preferred by customers, with many insisting on liners including this feature. The declaration provides examples of testimonial letters from satisfied customers, noting the superiority of the shaped liners and the value of their feature of preventing food from collecting in the corners.

The declaration also provides examples of "approved brand" and "no substitute" bid requests issued by satisfied customers, specifying the contour fit pan liner to the exclusion of products not having the claimed feature.

The declaration provides further detail regarding the assignee's sales of products embodying the invention. These sales have been substantial and have showed a steady increase as more and more commercial kitchens purchase and use pan liners according to the invention. The assignee's total pan liner sales for the past year were over \$2 million, reflecting a steady annual increase in sales since introduction of the product.

The applicant thus submits that there is substantial "secondary evidence" of patentability in virtually every category of such evidence recognized by the courts. Long-felt need, initial skepticism followed by praise and positive reaction, commercial success exemplified by widespread adoption by the food service industry, and the stated refusal by many customers to accept substitutes, are all present in this case. The direct evidence of patentability is sufficient to overcome any *prima facie* case of obviousness arguably made out by the cited references.

In conclusion, the references relied upon for the pending rejections illustrate simple technologies. The Ibsch patent issued in 1951, with the similarly-structured Binks and Ferlanti patents following in 1982 and 1989. The Geigel patent issued in 1967, followed by Van Erden in 1988. The essential structures relied upon in the rejections have thus been known since at least the 1960s (over 35 years), and have been the subject of continuing improvements. It is reasonable to ask why, if the invention and its advantages are obvious, was it never developed by another during that long period?

The answer is clear in view of the available secondary evidence. This invention was not obvious. When the inventor developed the claimed products, they were met with initial skepticism, but since then they have been embraced by a growing segment of the food service industry. The commercial success of the invention is confirmed by steadily increasing sales in seven figures. Even more telling, an increasing number of customers vote for this invention with their money, by specifying the inventive pan liners to the exclusion of competing products lacking the inventive feature, even though the competing products might be less expensive.

***Conclusion***

The applicant sincerely appreciates the courtesy extended by the Examiner and looks forward to the Examiner's further consideration of the case in view of the remarks and amendments submitted herewith. Applicant has endeavored to make the case ready for allowance, and reconsideration and withdrawal of all objections and rejections are respectfully requested. If any problems should appear and a telephone conference or personal interview would advance the case, the Examiner is invited to call the undersigned, who will cooperate in any appropriate manner to expedite prosecution.

Respectfully submitted,

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